U.S. Patent Appln. Ser. No. 10/635,563
Submission Responsive to Final Rejection dated September 21, 2007
Atty. Docket No. 72167.000403
October 30, 2007

REMARKS

The Final Rejection has been carefully reviewed. Claims 21-23, 25-27, 30-38, 40-42 and 45-50 are pending. Claims 21, 25-27, 36 and 40-42 have been amended. Claims 24, 28, 29, 39, 43 and 44 have been canceled. Support for the amendments can be found in the specification as originally filed at least at paragraphs [119] and [125]. No new matter has been added by way of these amendments.

Claims 21-23, 28-33, 35-38, 43-48 and 50 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 5,349,170 to Kem ("Kern") in view of U.S. Patent No. 5,784,610 to Copeland et. al. ("Copeland"), U.S. Patent No. 5,424,938 to Wagner et. al. ("Wagner") and U.S. Patent Application Publication No. 2004/0201735 to Baron ("Baron"). See Final Rejection at ¶ 4. Claims 24-27, 34, 39-42 and 49 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over Kern in view of Copeland, Wagner and Baron and further in view of Admitted Prior Art (APA) in the Background Section of the application. See Final Rejection at ¶ 13. Applicants respond as follows.

I.   Objections to the Specification and the Drawings.

Applicants amended the specification in response to the objections in the Office Action dated January 16, 2007. The Examiner has withdrawn these objections for which the Applicants thank the Examiner. See Final Rejection at ¶ 2.

Further, Applicants submitted replacement drawings in response to the objections to the drawings set forth in the Office Action dated January 16, 2007. The Examiner has accepted the replacement drawings, for which Applicants thank the Examiner.

II.   Objection to the Claims.

The Examiner has withdrawn the objections to the claims in light of the claim amendments filed on June 18, 2007, for which the Applicants thank the Examiner. See Final Rejection at ¶ 3

III.   Rejections under 35 U.S.C. § 112, Second Paragraph.

The Examiner previously rejected claims 3 and 9 under 35 U.S.C. § 112, second paragraph in the Office Action dated January 16, 2007. Applicants canceled claims 1-20 and note that the Examiner has apparently withdrawn these rejections.

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IV.   Rejections Under 35 U.S.C. § 103.

Claims 21-50 have been rejected as allegedly unpatentable pursuant to 35 U.S.C. § 103. *See* Final Rejection at ¶¶ 4, 13. A *prima facie* case of obviousness can be established by showing that the following three criteria are met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. See MPEP § § 2143 and 2143.03; citing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 1981 (CCPA 1974).

Additionally, under the Examination Guidelines For Determining Obviousness Under 35 U.S.C. In View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (October 10, 2007), the Examiner may establish a *prima facie* case of obviousness by setting forth factual findings concerning the state of the art and the teachings of the applied reference(s). *See id.* at 57,527. This includes determining "the scope and content of the prior art . . .; differences between the prior art and the claims at issue . . .; and the level of ordinary skill in the pertinent art . . ." *Id.; see also* MPEP § 2141; quoting *Graham v. John Deere*, 383 U.S. 1 (1966). The Examiner must then "provide an explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed." *Id.*

For at least the following reasons, the Examiner has failed to establish a *prima facie* case of obviousness under either of these methods. Accordingly, for at least the following reasons, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

A.   Claims 21-23, 28-33, 35-38, 43-48 and 50.

Claims 21-23, 28-33, 35-38, 43-48 and 50 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over Kern in view of Copeland, Wagner and Baron. *See* Final Rejection at ¶ 4.

The Kern Disclosure

Kern discloses a system and method for handling misplaced transaction documents in an image-based bank check processing system. *See* Abstract; col. 4, lines 65-68; Figs. 1, 2. The system and method of Kern comprises preparation of incoming transactions by arranging the documents in trays in proper orientation and order, with pocket separator tickets separating the documents into groups to permit identification of documents associated with each transaction

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(col. 5, lines 6-24); feeding the documents to a high speed document processor which reads the MICR code line, endorses audit trail information (including assigning a sequence number) on each document, optionally microfilming each document, capturing an image of each document, reading a dollar amount if the dollar amount has been encoded or is otherwise available and sorting the documents to pockets which may be based on the destination indicated by the MICR code line (col. 5, lines 25-49); feeding the data read from the transaction documents by the document processor to a computer where the data are stored (col. 5, lines 61-67); processing, compressing and forming the images captured by the document processor into image packets and sending the image packets for storage (col. 6, lines 1-9); entering dollar amounts of each check into the computer database and balancing transactions (col. 6, lines 38-44 and 47-53); and for balanced transactions, encoding the dollar amounts of each check (col. 6, lines 29-33). At the end of the process, the processed checks are ready for shipment to the appropriate destination. Col. 7, lines 38-39.

The system and method of Kern include a plurality of workstations which serve as a "primary interface" for entering dollar amounts and correction data into the computer database, and for balancing transactions. Col. 6, lines 54-59. Documents that need dollar amounts entered following processing by the document processor are sent to these workstations for dollar amount entry. Col. 6, lines 49-53. Other documents are also sent to the workstations. For example, documents that cannot be handled, for example due to a defective MICR code line, are sorted to a reject pocket and then sent to a workstation for MICR code line correction. Col. 5, lines 49-60; col. 7, lines 2-4. Other workstations balance transactions, and yet other workstations work with a printer to provide text and image hard copy output. Col. 7, lines 4-7. "Transaction balancing," as that term is used in Kern, means "proofing" a transaction to make sure that "the 'NET DEPOSIT' line on the front side . . . of the deposit ticket . . . equal[s] the algebraic sum of the associated check amounts and any cash paid in or paid out amount, and also the amounts of any other types of transaction items which may be included in the transaction." Col. 4, lines 21-28; col. 7, lines 8-9. "Proofing" is necessary when "a deposit transaction for which the total on the deposit ticket . . . does not equal the sum of the checks being deposited." Col. 15, lines 42-45. Once a transaction is balanced, it can be sent to the power encoder. Col. 7, lines 20-26.

The Copeland Disclosure

Copeland discloses a digital image archive and distribution system that includes an archive system and a distributed digital document image retrieval system. *See* Abstract.

The Wagner Disclosure

Wagner discloses an interface system for providing access to a plurality of payment networks that displays to a user a single transaction entry screen capable of initiating a monetary payment transaction over any of a number of differing payment networks. *See* Abstract.

The Baron Disclosure

Baron discloses storage of images in a digital camera in chronological order in an image storage queue. *See* Abstract.

Kern in combination with Copeland, Wagner and Baron does not support a *prima facie* case of obviousness.

The Examiner states, with regard to claims 21 and 36, that "Kern discloses a computer method and system for processing international and domestic collection items (Figure 1 and Abstract), the method comprising: receiving a plurality of collection items and documents accompanying the collection items (Figure 1 and column 3, line 21 – column 4, line 28); sorting and indexing each received collection item in accordance with a predetermined collection item type (column 5, lines 6-25 and lines 41-45); scanning the collection item to create an image of the collection item (column 5, lines 26-38); determining if any machine-readable code exists on the collection item (column 5, lines 26-60); if any machine-readable code is determined to exist on the collection item, reading that code by machine (column 5, line 26 – column 6, line 20); scanning any documents accompanying the collection item to create an image for each accompanying document (column 5, line 26 – column 6, line 20); saving the scanned collection item, the scanned endorsed collection item, if any, the code readout, if any, and each scanned accompanying document in a database (column 4, lines 29-35 and column 5, line 61 – column 6, line 20); displaying a balance and distribution screen at a user display (item 50c in Figure 14; and column 15, line 38 – column 16, line 3); and distributing funds and balancing accounts of processed collection items (column 15, lines 38-53)." Final Rejection at ¶ 5. The Examiner states further that "Kern does not explicitly disclose saving the scanned items and data as a unit of work and designating each unit of work a searchable unique database index key, or retrieving

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a unit of work from the database and displaying selected images from the unit of work at a user display connected to a client." Final Rejection at ¶ 5.

The Examiner asserts that "Copeland . . . discloses a system for processing, scanning and storing checks (Figure 2 and Abstract) including receiving information from one or more scanners and associating the collection item and any associated documents together as an image-based unit of work (column 5, lines 11-35 and column 10, lines 55-65) and designating each unit of work as a searchable unique database index key (column 11, lines 63-67), for the purpose of making the optimum use of image technology capabilities and providing maximum ease of use (column 2, lines 59-62) . . . Copeland further discloses a database to store the scanned and extracted information (column 7, line 61 – column 8, line 2) so as to be retrievable on a unit of work basis and displayed on a workstation display (column 14, lines 54-59)." Final Rejection at ¶ 5. According to the Examiner, "it would have been obvious to one o[f] ordinary skill in the art at the time the invention was made to modify Kern to associate related scanned data as a unit of work designated by a unique identifier, and making the data retrievable on a unit of work basis for display, in order to make optimum use of the image technology capabilities and provide maximum ease of use, as taught by Copeland." Final Rejection at ¶ 5.

The Examiner also asserts that "Kern does not explicitly disclose automatically filling processing data into a processing display relating to the collection item if the processing data were stored in the database, or inputting processing data including: the party to whom the payment will be made, the party that issued the collection item, and the method by which payment of the collection item is to be settled . . . Kern further does not disclose processing payment of collection items or a server configured to provide an interface with external system." Final Rejection at ¶ 5. The Examiner asserts that "Wagner . . . discloses a method and apparatus for providing access to a plurality of payment networks (Figure 1 and Abstract) including accepting input from the user (Figures 3-10 and column 2, lines 40-53), and performing processing of the collection item in accordance with the user's input (column 2, lines 40-53) for the purpose of providing a display interface to initiate and complete monetary transfers using a variety of payment networks (column 2, lines 27-37)." Final Rejection at ¶ 5. According to the Examiner, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kern [to] process a collection item on the user's input in order to

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enable the user to selectively process the collection item on a specified payment network." Final Rejection at ¶ 5.

The Examiner additionally states that "Wagner further discloses automatically filling input fields with previously stored data (column 6, lines 1-18) for the purpose of expediting and facilitating the entry of repetitive data previously entered and stored." Final Rejection at ¶ 5. The Examiner states that "it would have been obvious to one o[f] ordinary skill in the art at the time the invention was made to modify Kern to automatically populate input fields with stored information in order to expedite and facilitate the entry of such information." Final Rejection at ¶ 5.

The Examiner also states that "Wagner discloses generating a payment screen (Figures 3-10 and column 6, lines 1-18), the payment screen accepting input relating to (a) the party to whom the payment is to be made, (b) the party that issued the collections item, (c) the amount of the payment; and (d) the method of payment." Final Rejection at ¶ 5. Additionally, according to the Examiner, "Wagner further discloses providing a network interface between the central computer and the external payment networks. (Figure 1 and column 3, line 59 – column, line 50)." Final Rejection at ¶ 5.

The Examiner finally states that "Kern does not explicitly disclose a server to create queues for storing da[ta] to be used during processing of the collection items and dynamically track and update the status of the queues, provide an-interface with external systems, and access unit of work data stored in the database whereby the data from the database are available to the client and interface with external systems." Final Rejection at ¶ 5. Baron, according to the Examiner, "discloses an image storage queue (Figure 3, paragraph 0032) including creating queues for storing data to be used during processing of the system (paragraph 0013), and dynamically tracking and updating status of the queues (paragraphs 0018 and 0025) for the purpose of efficiently managing the storage space available in the memory storage unit (item 106 in Figure 1)." Final Rejection at ¶ 5. According to the Examiner, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kern to incorporate a queue for storing image data in order to better manage the available storage space in the database." Final Rejection at 5.

Applicants respectfully submit that Kern in combination with Copeland, Wagner and Baron does not support a *prima facie* case of obviousness. Independent claims 21 and 36 claim a system and method for processing both international and domestic collection items not suggested or disclosed in Kern. Claim 21 claims the following limitations that are not disclosed, taught, suggested or motivated by Kern:

B. sorting and indexing each received collection item in accordance with a predetermined collection item type comprising international collections item types and domestic collections item types;

C. scanning the collection item to create an image of the collection item, wherein a user of the system determines the method to scan the collection item and the user initiates the scanning method, wherein scanning comprises scanning with a check scanner if the incoming collection item is a check and scanning comprises scanning with a flatbed scanner if the incoming collection item is not a check;

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F. determining by the user of the system if the collection item needs to be endorsed, endorsing the collection item, if necessary and scanning the endorsed collection item to create an image of the endorsed collection item;

G. thereafter scanning any documents accompanying the collection item to create an image for each accompanying document;

H. saving by the user the scanned collection item, the scanned endorsed collection item, if any, the code readout, if any, and each scanned accompanying document as a unit of work in a database and designating each unit of work a searchable unique database index key; and

I. retrieving by the user a unit of work from the database and displaying selected images from the unit of work at a user display connected to a client.

Claim 36 has corresponding system claims.

There are numerous distinctions between Kern and the inventions of claims 21 and 36. As an initial matter, Kern does not provide any procedure for processing certain items, specifically items that do not include MICR microcoded entry data. Rather, Kern *uses* the MICR code entry data to sort items according to destination so that destination shipment

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deadlines can be met. *See* col. 5, lines 41-48. If MICR code entry data is defective and has no readable destination, those documents are directed to a workstation to correct the MICR code line information. *See* col. 14, lines 48-51. Kern discloses that such "reject reentry procedures" are "slow and labor intensive," and that documents having defective MICR code line data are sorted according to that data so long as the destination portion of the MICR portion is readable. *See* col. 14, lines 51-60. There is no disclosure in Kern of any system or method capable of processing documents that do *not* have MICR code line data.

In contrast, claims 21 and 36 include limitations not found in Kern that permit the processing of items that do *not* have MICR code data. Specifically, claims 21 and 36 expressly sort and index each received collection item in accordance with a predetermined collection item type comprising international collections item types and domestic collections item types. The specification discloses that certain international collection items, for example foreign checks, do not include microcoded (MICR) routing numbers. *See* paragraph [127]. Additionally, the express use of a flatbed scanner for scanning non-check items is disclosed in the specification for use on items that do not include MICR code data. *See* paragraph [70]. In order to accomplish scanning according to proper procedures, the user of the system and method of claims 21 and 36 selects the method to scan the collection item according to whether the collection item is a check containing MICR code data, in which case a check scanner can be used; otherwise, a flatbed scanner is used to scan the item to create an image. In contrast, in Kern, *all* items are scanned in a high speed document processor with no input by a user of the system of Kern. *See* col. 5, lines 25-30. Accordingly, the system and method of claims 21 and 36 operate in a fundamentally different way from that of Kern in sorting the documents, in that Kern requires MICR code data to determine a destination to sort and ultimately ship the processed document, whereas in the invention documents are sorted according to collection item types that do not depend on the presence of MICR code data. There would be no reasonable expectation of success of sorting documents into domestic and international collection item types according to MICR code data in Kern since certain international collection item types such as foreign checks do not include MICR code data.

There are additional distinctions in the system and method of claims 21 and 36 over Kern as well. For example, in the process of the invention of claim 21, documents accompanying the

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collection item are scanned *after* the collection item is scanned and endorsed, if deemed necessary by the user of the system, and *then* associated with the image of the collection item. In contrast, in Kern, *all* documents are scanned and images are created *before* items are referred to workstations. *See* col. 5, lines 5-60; col. 6, lines 54-66.

Further, the user of the system in claims 21 and 36 determines the scanning method and initiates the scanning process for each type of collection item, whereas in Kern *all* documents are scanned automatically by a single high speed document processor, with no regard to type of collection item or method of scanning. The system and method of the invention allows for different scanning methods for different types of documents, namely checks and other documents. Checks are scanned by a check scanner whereas other types of documents are scanned by flatbed scanning.

The differences between Kern and the system and method of claims 21 and 36 are due at least in part to the fact that the inventions permit processing of all types of collection items, not just checks that include MICR data as in Kern. Thus, there is no teaching, suggestion or motivation in Kern to modify it to allow processing of items that do not include MICR code data, such as foreign checks, or to permit a user of the system to determine the scanning method according to the type of collection item and initiate scanning.

Regardless, a combination of Kern with any and all of Copeland, Wagner and Baron does not cure the defects of Kern. None of Copeland, Wagner and Baron disclose a system and method for processing collection items including international collection items that do *not* include MICR code data, and also permit a user of the system to determine the scanning method according to the type of collection item and initiate scanning. Accordingly, none of Copeland, Wagner or Baron cure the deficiencies of Kern and a *prima facie* case of obviousness cannot be supported by a combination of these references. Additionally, there would be no reasonable expectation of success to achieve the inventions by combining Kern, Copeland, Wagner and Baron because there is no capability to process items that do not include MICR code data, such as foreign checks, or to permit a user of the system to determine the scanning method according to the type of collection item and initiate scanning as in the inventions. Finally, the combination of Kern, Copeland, Wagner and Baron do not disclose each and every limitation of claims 21 and

36, as noted above, and no *prima facie* case of obviousness can be supported by this combination.

The cited references, alone or in combination, do not support a *prima facie* case of obviousness of independent claims 21 and 36, Applicants respectfully request withdrawal of the rejection of these claims and claims 22, 23, 28-33, 35, 37, 38, 43-48 and 50, which depend from claims 21 and 36.

B.   Claims 24-27, 34, 39-42 and 49.

Claims 24-27, 34, 39-42 and 49 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over Kern in view of Copeland, Wagner and Baron and further in view of APA. *See* Final Rejection at ¶ 13. APA also does not cure the deficiencies of the combination of Kern, Copeland, Wagner and Baron in that APA also does not disclose a system or method with the capability to process items that do not include MICR code data, such as foreign checks, or to permit a user of the system to determine the scanning method according to the type of collection item and initiate scanning as in the inventions. Therefore, this combination does not support a *prima facie* case of obviousness of claims 24-27, 34, 39-42 and 49, which depend from either claims 21 or 36. Applicants respectfully request withdrawal of this rejection.

C.   The Examiner has not set forth a case for obviousness under the new Examination Guidelines.

The Examiner has also not set forth a case of obviousness of claims 21-50 under the new Examination Guidelines as set forth at 72 Fed. Reg. 57,526 (October 10, 2007). There are no factual findings concerning the state of the art and the teachings of the applied reference(s) to establish obviousness, as required. *See id.* at 57,527. There is no "explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed." *Id.*

The new Guidelines state that some rationale must be set forth that outlines the reasoning why an invention is obvious. *See id.* at 57,528 (III). Suggested but non-inclusive rationales are described including:

1.   Combining prior art elements according to known methods to yield predictable results;

2.   Simple substitution of one known element for another to obtain predictable results;

3.   Use of known techniques to improve similar devices (methods, or products) in the same way;

4.   Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

5.   "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasaonable expectation of success;

6.   Known work in one field of endeavor that may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and

7.   Some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants have already addressed the last rationale listed above and respectfully submit that the Examiner has not set forth any of the other rationales (or any other rationales either) to support a finding of obviousness. Further, there are no factual findings set forth in the Final Rejection regarding the scope and content of the prior art; ascertainment of the differences between the claimed invention and the prior art; and resolution of the level of ordinary skill in the pertinent art, all three of which are required to support a finding of obviousness by the Examiner.

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CONCLUSION

Applicants respectfully submit that claims 21-23, 25-27, 30-38, 40-42 and 45-50 are in condition for allowance and request allowance of the same.
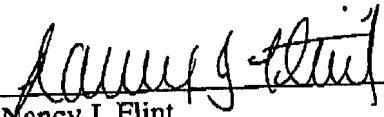
This Submission and Request for Continued Examination has been filed within two months of the mailing date of the Final Rejection and it is believed that the only fees due are those for filing the Request for Continued Examination. The Commissioner is authorized to deduct a total amount of $810.00 from the undersigned's Deposit Account No. 50-0206 for the Request for Continued Examination. If any variance of fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from or credit such fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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